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In re Application of: Chen-Tsai LEE)
Application No. 09/886,225) DECISION ON PETITION TO
Attorney Docket No. P-3641.147) WITHDRAW HOLDING OF
Filed: June 21, 2001) ABANDONMENT UNDER 37 CFR
For: MEMORY INTERLACE-CHECKING) §1.181
METHOD)

This is a decision on the petition filed March 17, 2005, entitled "Petition for Revival of an Application for patent abandoned Unintentionally under 37 C.F.R. §1.137(a)". The petition is being treated as a petition to withdraw the holding of abandonment of the above-identified application, under 37 C.F.R. §1.181.

The instant application was indicated to be abandoned for failure to properly respond to the Office action (Final Rejection) mailed February 27, 2004. A Notice of Abandonment was mailed on March 1, 2005.

The Petition is **DENIED**.

Recent Prosecution History

On September 8, 2003, a Non-Final Office action was mailed.

On December 11, 2003, an amendment was filed in response to the Non-Final Office action.

On February 27, 2004, a Final Office action was mailed.

On June 21, 2004, an after final amendment and response were filed along with a one-month extension of time.

On December 6, 2004, a status letter was filed.

On December 29, 2004, a copy of the amendment and response filed on June 21, 2004 was filed via facsimile, along with a copy of the request for a one-month extension of time.

On February 23, 2005, an Advisory Action was mailed, indicating that the amendment submitted after Final Rejection on June 21, 2004 (copy filed December 29, 2004) would be entered for purposes of appeal but that the amendment and response failed to place the instant application in condition for allowance.

On March 1, 2005, a Notice of Abandonment was mailed.

On March 17, 2005, the instant petition was filed.

Relief Requested

The instant petition requests the following relief: withdrawal of the holding of abandonment.

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. *Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.* In addition § 1.181(f) sets forth: *any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely* [emphasis added]. Further, when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR §1.111) and a repeated action by the examiner.

The petition initially filed on March 17, 2005 includes elements (1) and (2) above and was filed within two months from notification of the abandonment. No fee under 37 C.F.R. §1.181 is required for this petition.

Basis of Opinion

37 CFR §1.113 Final rejection or action

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR §1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

- (a) An amendment after final action must comply with § 1.114 or this section.
- (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
 - (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
 - (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

37 CFR §1.134 Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. *Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.*

35 U.S.C. 133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it is shown to the satisfaction of the Director that such delay was unavoidable.

37 C.F.R. §1.135(b) Abandonment for failure to reply within time period.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. *The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.*

Decision

In support to the petition, Applicant provides: a copy of the Notice of Abandonment; a copy of the Advisory Action; a copy of the amendment, response, request for one-month extension of time (with a check in the amount of \$110.00) and copy of the post-card receipt with an OIPE date of June 21, 2004; as well as a copy of the status letter of December 6, 2004; and an auto reply facsimile transmission for copies of papers submitted on December 29, 2004.

In order to clarify the prosecution record, a brief analysis will be proffered. Following the Final Office action (mailed February 27, 2004), Applicant submitted a timely filed amendment under 37 CFR §1.116 on June 21, 2004. Unfortunately, due to Office scanning and processing delays, the amendment was not forwarded to the Examiner until February 10, 2005 for action on the merits. As identified in the Advisory Action mailed on February 23, 2005, the amendment submitted June 21, 2004 (copy provided December 29, 2004), did not satisfy After Final practice under 37 C.F.R. §1.116 for entry of the response by placing the application clearly in condition for allowance, but was enterable as set forth in 37 CFR §1.116(b)(2), pending the filing of a Notice of Appeal.

However, and in accordance with 37 CFR §1.135(b), Applicant failed to file a timely Notice of Appeal within the six-month statutory period set forth in the final Office action (six month period expired August 27, 2004) in order to save the instant application from abandonment. Applicant is reminded ***“the admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment”***.

Finally, since expiration of the statutory period of sixth months from the mailing of the Final rejection on February 27, 2004 had expired prior to the mailing of the Notice of Abandonment on March 1, 2005, the holding of abandonment is maintained and deemed to be proper in accordance with 35 U.S.C. 133.

The petition to withdraw the holding of abandonment is therefore **DENIED**.

If Applicant desires to continue prosecution of this application, Applicant may wish to file a complete petition to revive under 37 CFR §1.137(a) (unavoidable delay) or 37 CFR §1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay

A grantable petition to revive an abandoned application under 37 CFR §1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in §1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

The showing of requirements can be met by submission of a statement of facts establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR §1.137(b) might be appropriate.

II. Unintentional Delay

A grantable petition to revive an abandoned application under 37 CFR §1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;

- (2) The petition fee as set forth in §1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

The required items, including appropriate fee, should be promptly submitted under a cover letter entitled "Petition to Revive under 37 CFR §1.137(a) or (b)", as deemed appropriate.

Telephone inquiries should be directed to Special Programs Examiner Brian Johnson at (571) 272-3595.

A handwritten signature in black ink, appearing to read "Jack Harvey", is written over a horizontal line.

Jack Harvey, Group Director
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Computer Architecture, Software, and Information Security